UNITED STATES PATENT AND TRADEMARK OFFICE

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09/803,339	03/09/2001	Richard A. Wiltshire	122923-1000	7334

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EXAMINER
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ART UNIT	PAPER NUMBER
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/803,339	WILTSHIRE ET AL.
	Examiner	**Art Unit**	
	Travis R. Banta	3714	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>11 June 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-14,30,31 and 45-51</u> is/are pending in the application.

    4a) Of the above claim(s) <u>15-29 and 32-44</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-14,30,31 and 45-51</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

By the amendment filed on June 11, 2007, claims 1-14, 30, 31 and 45-51 remain

pending. All claims stand rejected.

The Applicant has also filed a Declaration pursuant to 37 C.F.R. § 1.131 with

supporting exhibits. These have been reviewed by the Examiner but are not effective to

disqualify Yacenda '446 as prior art. The Applicant has not established that his

invention was reduced to practice prior to the effective date of the reference, or

conception of the invention prior to the effective date of the reference coupled with due

diligence from prior to said date to a subsequent reduction to practice or to the filing of

the application. Original exhibits of drawings or records, or photocopies thereof, must

accompany and form part of the affidavit or declaration or their absence must be

satisfactorily explained.

In this case the Applicant has provided a receipt for a DVD the Applicant states

to contain executable software files. While the Examiner has no reason not to believe

the Applicant as to the content of the DVD, exhibit B as submitted shows an

extraordinarily unclear picture with the dates blacked out. The Examiner has no way of

ascertaining the date of the screen shot. Exhibit C is intended to show the HTML file of

the "check1.htm" file stated to be on the DVD. In this case, the date is also blacked out.

Additionally, the Examiner can't read the URL address to even see that the file is from

the DVD. Exhibit D shows the files of the "Icheck.tar" archive. Again, the dates are

blacked out. The Examiner has no way of ascertaining the date of these files as prior

evidence of conception. Exhibit E shows another blurry image of a screenshot with

blackened dates. There is no way for the Examiner to establish a date prior to the date

of Yacenda '446. Exhibit F displays the cache files for a lotto program. Again, all

relevant dates have been blackened.

From these Exhibits, the Examiner cannot establish a reduction to practice date

prior to the date of filing of Yacenda. Even assuming the stated DVD contains the files

the Applicant suggests it has, there is no date on the receipt for the DVD. None of the

submitted evidence is sufficient to swear behind Yacenda ('446

Additionally, diligence has not been properly established. Referring to the MPEP

715.07(a): "In determining the sufficiency of a 37 C.F.R. § 1.131 affidavit or declaration

diligence need not be considered unless conception of the invention prior to the

effective date is clearly established since diligence comes into question only after prior

conception is established." Thus, diligence is not at issue since a clear date of

conception has not been established.

Even if a clear date of conception had been established "An applicant must

account for the entire period during which diligence is required" (MPEP 2138.06 -The

entire period during which diligence is required must be accounted for by either

affirmative acts or acceptable excuses). Continuing, "A 2-day period lacking activity has

been held to be fatal"...."Diligence requires that applicants must be specific as to dates

and facts". As such, general statements of nights and weekends spent working towards

reduction to practice is insufficient to establish diligence. The Applicant has been

accorded his initial filing date for purposes of Examination. The declaration under 37

C.F.R. § 1.131 is insufficient.

The period from conception to filing is at least 13 months from the date of the

provisional application. The Applicant is not permitted to swear behind a reference filed

more than 12 months before the Applicant's filing date (see MPEP 715 (I)(A)).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) he has abandoned the invention.

Claims 1-14, 30-31, and 45-51 are rejected under 35 U.S.C. 102(c) because the

invention has been abandoned. The Applicant has attempted to swear behind the

Yacenda reference filed December 10, 1999. The Applicant filed a provisional

application on January 30, 2001. There are at least thirteen months of activity

unaccounted for after the Applicant claims to have reduced his invention to practice.

This presents a prima facie case of abandonment of the invention since an application

for patent was not filed in the intervening time.

If the Applicant wishes to traverse this rejection, the Applicant must satisfactorily

explain why the application was not filed for 13 months after the reduction to practice of

the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-14, 30-31, and 45-51 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Texas Lotto Club in view of Snowden et al. US(5,417,424) in further

view of Yacenda US(6,322,446).

Regarding claim 1, Texas Lotto Club describes a lottery pool management

system that is configured to communicate with several participant computers, also

configured to enable a plurality of pool participants to participate in several lottery pools

and enables participants to exchange information before the pool drawings, also

enabled to inform participants via computer of all the sets of numbers that have been

entered prior to the drawing and sharing with any winnings of the lottery with the

multiple players (see Way Back machine under www.texaslottoclub.com FAQs). Texas

Lotto Club fails to teach a method of determining if a winning event has occurred within

a given set of numbers. In an analogous machine, Snowden et al. ('424) teaches the

use of a player operated win checker to determine whether a winning event has

occurred (see abstract). It would have been obvious at the time of the invention to

combine the player operated automated win checker with the Texas Lotto Club system

as it would be unwieldy for an individual to compare the numbers of so many lottery

tickets by hand. Such a combination would facilitate ease in determination of a winning ticket.

Texas Lotto Club and Snowden et al. ('424) fail to teach using a computer system to notify participants of a winning lottery number. In another similar machine, Yacenda ('446) teaches the use of a notification interface on several participant and agent networks to inform participants of lottery winnings via a computer interface (see column 3 lines 55-60). It would have been obvious at the time of the invention to combine Yacenda ('446)'s notification system with the Texas Lotto Club and Snowden ('424) to provide automatic notification as a result of the automatic determination of a win.

Regarding claim 2, The Texas Lotto Club manager states that his motivation for creating the club is to win the lottery and that he participates in the lottery pool. Thus, pool participants can create new lottery pools (see Way Back Machine, www.texaslottoclub.com FAQ "How do you run the club for free?")

Regarding claim 3, Yacenda ('446) discloses a ticket entry module to allow participants to enter numbers into the pool and change the numbers (see abstract).

Regarding claim 4, Texas Lotto Club provides a system to allow participants to view pool history including past numbers, players, and groups. It also discloses notifying those participating in a lottery pool after a total payout of $15 million is reached (see way back machine, www.texaslottoclub.com).

Regarding claim 5, Texas Lotto Club teaches players can play the lottery with any numbers that are desired although the website teaches a suggested method of play. (see way back machine, www.texaslottoclub.com).

Regarding claim 6, Yacenda ('446) teaches a lottery interface configured to retrieve rules associated with a lottery (see Fig 2A –105).

Regarding claim 7, Yacenda ('446) teaches purchasing tickets at the request of any lottery participants (see abstract).

Regarding claim 8, Snowden ('424) teaches notification to players as a result of a completed drawing (see abstract).

Regarding claim 9, Texas Lotto Club teaches the notification of participants when the total payout of the lottery exceeds $15 million (see way back machine www.texaslottoclub.com FAQ).

Regarding claim 10, Snowden ('424) and Texas lotto club teach the use of a database in lottery management (see figure 1 and way back machine www.texaslottoclub.com).

Regarding claim 11, Snowden ('424) teaches the use of a database in lottery management including number information (see figure 1).

Regarding claim 12, Texas lotto club teaches databases which contain information on lottery pools (see way back machine www.texaslottoclub.com).

Regarding claim 13, Texas lotto club teaches databases which contain information concerning pool participants (see way back machine www.texaslottoclub.com).

Regarding claim 14, Texas lotto club teaches databases which contain

information concerning a lottery (see way back machine www.texaslottoclub.com).

Regarding claim 30, it is well known that computers using the internet are

involved in a global communications network including one or more participant

computers. The Texas lotto club also teaches a lottery pool management server in

communication with participants via the internet (a global communications network).

Texas Lotto Club also describes a lottery pool management system that is

configured to communicate with several participant computers, also configured to

enable a plurality of pool participants to participate in several lottery pools and enables

participants to exchange information before the pool drawings, also enabled to inform

participants via computer of all the sets of numbers that have been entered prior to the

drawing and sharing with any winnings of the lottery with the multiple players (see Way

Back machine under www.texaslottoclub.com FAQs). Texas Lotto Club fails to teach a

method of determining if a winning event has occurred within a given set of numbers. In

an analogous machine, Snowden et al. ('424) teaches the use of a player operated win

checker to determine whether a winning event has occurred (see abstract). It would

have been obvious at the time of the invention to combine the player operated

automated win checker with the Texas Lotto Club system as it would be unwieldy for an

individual to compare the numbers of so many lottery tickets by hand. Such a

combination would facilitate ease in determination of a winning ticket.

Texas Lotto Club and Snowden et al. ('424) fail to teach using a computer

system to notify participants of a winning lottery number. In another similar machine,

Yacenda ('446) teaches the use of a notification interface on several participant and

agent networks to inform participants of lottery winnings via a computer interface (see

column 3 lines 55-60). It would have been obvious at the time of the invention to

combine Yacenda ('446)'s notification system with the Texas Lotto Club and Snowden

('424) to provide automatic notification as a result of the automatic determination of a

win.

Regarding claim 31, the manager of the pool notes on the Texas Lotto Club

website that his desire in operating the pool is that he wants to win the lottery. Thus he

is a participant in the pool and pool participants can create new lottery pools (see way

back machine www.texaslottoclub.com FAQ).

Regarding claim 45, Texas Lotto Club describes a lottery pool management

system for operation on an electronic communications network that is configured to

communicate with several participant computers, also configured to enable a plurality of

pool participants to participate in several lottery pools and enables participants to

exchange information before the pool drawings, also enabled to inform participants via

computer of all the sets of numbers that have been entered prior to the drawing and

sharing with any winnings of the lottery with the multiple players (see Way Back

machine under www.texaslottoclub.com FAQs). Texas Lotto Club fails to teach a

method of determining if a winning event has occurred within a given set of numbers. In

an analogous machine, Snowden et al. ('424) teaches the use of a player operated win

checker to determine whether a winning event has occurred (see abstract). It would

have been obvious at the time of the invention to combine the player operated

automated win checker with the Texas Lotto Club system as it would be unwieldy for an

individual to compare the numbers of so many lottery tickets by hand. Such a

combination would facilitate ease in determination of a winning ticket.

Texas Lotto Club and Snowden et al. ('424) fail to teach using a computer

system to notify participants of a winning lottery number. In another similar machine,

Yacenda ('446) teaches the use of a notification interface on several participant and

agent networks to inform participants of lottery winnings via a computer interface (see

column 3 lines 55-60). It would have been obvious at the time of the invention to

combine Yacenda ('446)'s notification system with the Texas Lotto Club and Snowden

('424) to provide automatic notification as a result of the automatic determination of a

win.

Regarding claim 46, the manager of the pool notes on the Texas Lotto Club

website that his desire in operating the pool is that he wants to win the lottery. Thus he

is a participant in the pool and pool participants can create new lottery pools (see way

back machine www.texaslottoclub.com FAQ).

Regarding claim 47, Yacenda ('446) discloses a ticket entry module to allow

participants to enter numbers into the pool and change the numbers (see abstract).

Regarding claim 48, Texas Lotto Club provides a system to allow participants to

view pool history including past numbers, players, and groups (see way back machine,

www.texaslottoclub.com).

Regarding claim 49, the combination as disclosed between Texas lotto club,

Snowden et al ('424) and Yacenda ('446) is configured to enable a notification interface

of notifying players of a win. It is inherent that such a device would also be a

comparison module to determine if the results were winners at any time.

Regarding claim 50, Yacenda ('446) teaches purchasing tickets at the request of

any lottery participants (see abstract).

Regarding claim 51, the combination as disclosed between Texas lotto club,

Snowden et al ('424) and Yacenda ('446) is configured to enable a notification interface

of notifying players of a win. It is inherent that such a device would also be a

comparison module to determine if the results were winners at any time. A notification

interface would also display the winning numbers to a player and which/how many were

winning numbers.

Response to Amendment

The Applicant has argued for claim 1 that none of Texas Lotto Club, Snowden, or

Yacenda show a lottery interface resident on a management server computer system in

communication with lotteries and with a participant interface for ascertaining drawing

results, jackpot amounts, comparing the drawing results with sets of lottery numbers

and recognizing a winning event.

The Examiner respectfully disagrees. The Examiner quotes from the cited Texas

Lotto Club FAQ page: "What's the advantage of joining the Texas Lotto Club?

When you join the Texas Lotto Club, you will be given many more chances to win lotto

cash than you could get if you played on your own. First of all, you will be placed in a

Lotto Group with up to 99 more people. This Group will provide you with up to 1,000

chances to win up to $5,000,000 or more in lotto cash! We also provide a periodic

statement regarding your Credit Account, as well as photocopies of the lotto tickets with

your personally assigned picks. Finally, our web page is updated twice weekly with the

results of our participation in the lotto events."

This teaches specifically, a lottery interface resident on a management server in

communication with a lottery ("a web page updated twice weekly") for ascertaining

drawing results ("results of our participation"), jackpot amounts ("$5,000,000 or more),

and comparison of a drawing result ("photocopies of the lotto tickets"... with "results of

our participation"). Snowden recognizes a winning event and is properly combined as

obvious with the Texas lotto club disclosure. Neither Snowden nor Yacenda are relied

upon for teaching of a lottery interface resident.

The Applicant further argues for claim 2 that none of the references teach or

disclose an interface resident on a management server which includes a lottery creation

module to allow pool participants to create new lottery pools. As cited in the rejection,

though perhaps unclearly, the manager of the club is a participant. The manager

creates new lottery pools. Thus, participants can create new lottery pools.

Further for claim 3, the Applicant has argued none of the references suggest a

provision of a ticket entry module that allows changing ticket numbers that were entered

previously. The Examiner respectfully disagrees. Yacenda teaches a ticket entry

module. As combined with Texas lotto club, which allows members to make their own

picks, a ticket is printed with the appropriate numbers. Such a device inherently allows

a player to change the numbers the player would like on his ticket.

Further for claim 4, the Applicant has argued Texas lotto club does not teach a module to allow players to participate in a club in successive lotteries, including a history module, and a notification interface when the jackpot reaches a specified level. The Examiner respectfully disagrees. The Texas lotto club is a club. The club participates in the Texas Lotto in which any minimum jackpot is greater than $15,000,000. Further disclosed is a website that shows results of player participation in the lottery results (a history module). A purchased ticket number in the $15,000,000 lottery is a notification that a jackpot has reached $15,000,000.

Still further for claim 5, the Applicant has argued there is no suggestion in the references the players can replay numbers. The Examiner respectfully disagrees. Texas Lotto Club (cited above) says players can make their own picks ("personally assigned picks"). Therefore, players can replay their own numbers if they re-pick the same numbers.

Further for claims 6,7, and 8, the Applicant argues none of the cited references disclose the features of these claims. The Examiner respectfully disagrees. The locations of the features are addressed in the rejection above.

The Applicant has argued for claims 30 and 45 with the same reasoning that applied to claim 1. The discussion of a lottery interface is believed to be addressed above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Travis R. Banta whose telephone number is (571) 272-

1615. The examiner can normally be reached on Monday-Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Bob Pezzuto can be reached on (571) 272-6996. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TB

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